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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,769	06/28/2001	Yoshiki Kawaoka	3562-0118P	3442
2292	7590	10/20/2006	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			ARAQUE JR, GERARDO	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/892,769

Applicant(s)

KAWAOKA ET AL.

Examiner

Gerardo Araque Jr.

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1 – 2, 4 – 5, 7 – 14, 28, and 30** are rejected under 35 U.S.C. 102(b) as being anticipated by **Fredlund et al.** (US Patent 5,666,215).
4. In regards to **claim 1**, Fredlund discloses a photofinisher that receives film from a customer, scans the film, and stores the scanned images (Column 2 Lines 28 – 31), wherein the receiving unit receives the plurality of images from a corresponding user automatically in accordance with an instruction which is determined by each user in advance (Column 7 Lines 18 – 19). Moreover, the images files are stored in a storage device, which were scanned from the photofinisher (Column 4 Lines 34 – 36). Furthermore, Fredlund also discloses a CD-writer for producing Photo CD's (Column 7 Lines 26 – 27).
5. In regards to **claim 2**, Fredlund discloses that the processed film is also scanned into a scanner in order to convert the negative film into digital images (Column 3 Lines 29 – 31) and is attached with a customer identification number (Column 3 Lines 34 –

36). Once the images are converted they can be later recorded onto a Photo CD, as was previously discussed.

6. In regards to **claim 4**, Fredlund discloses that once the customer is done with placing an order (Column 6 Lines 30 – 36) the images can then be recorded onto a CD with the use of a CD-writer (Column 8 Lines 56 – 63).

7. In regards to **claim 5**, Fredlund discloses a computer data entry means that allows a user to input information related to their images (Column 5 Lines 44 – 51). This information can then be recorded onto a recording media if the user chooses to.

8. In regards to **claim 7**, the examiner understands that the date and the place are just more information that the user can input into the database that further identifies the images. When the user accesses the database to have select the images they would want recorded they can do so based on the information that was provided. Moreover, it is well known that digital cameras use such information in order to organize the images on its storage medium and that cameras inherently have some type of GPS unit imbedded in them so that phone companies can track where phone calls are being made and determine if the phone is in a roaming area. Therefore, when the images are transmitted to their location through the cellular phone a tag, such as the date and location, must be sent with it so that the phone company can later charge the user for the extra service.

9. In regards to **claim 8**, Fedlund discloses a system and method for facilitating ordering and re-ordering of prints from negatives (Column 2 Lines 45 – 27). Moreover,

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Fredlund discloses a computer that controls an image-capable printer for paper prints (Column 7 Lines 18 – 26).

10. In regards to **claim 9**, Fredlund discloses that once the customer chooses which images to be re-ordered, the customer is presented with services related to the selected image, such as the quantity and the size (Column 2 Lines 47 – 57 Column 3 Lines 52 – 63).

11. In regard to **claims 10 and 11**, Fredlund discloses a mass storage device that stores the, "...digital image along with a customer order number and a unique customer identification number (Column 3 Lines 33 – 36)." The customer is then able to use the identification number given to them to access the images they would like to be printed (Column 4 Lines 46 – 50).

12. In regard to **claims 12 – 14**, Fredlund disclosure of a photo production and delivery system that allows customers to submit images to a storage device and assign the customers with an identification number is discussed above. The identification number allows them to access the storage device and select the images they would like printed or recorded on a medium. In the case that the customer would like the images to be recorded on a medium, such as a CD, a CD-writer that is integrated to a computer system would be used. Moreover, the optical disc would have the identification number and image recorded on it (Column 3 Lines 32 – 36).

13. In regards to **claim 28**, Fredlund discloses a photofinisher that receives film from a customer, scans the film, and stores the scanned images (Column 2 Lines 28 – 31), which can be found at a photo store, drugstore, or supermarket (Column 3 Lines 25 –

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27). Moreover, the images files are stored in a storage device, which were scanned from the photofinisher (Column 4 Lines 34 – 36). Furthermore, Fredlund also discloses a CD-writer for producing Photo CD's (Column 7 Lines 26 – 27). The order is then completed automatically (Column 7 Lines 18 – 19), the images can be returned to the customer by mail or picked up by the customer at the location where there were dropped off (Column 3 Lines 39 – 42).

14. In regards to **claim 30**, Fredlund discloses that the processed film is also scanned into a scanner in order to convert the negative film into digital images (Column 3 Lines 29 – 31) and is attached with a customer identification number (Column 3 Lines 34 – 36). Fredlund also discloses a mass storage device that stores the, "...digital image along with a customer order number and a unique customer identification number (Column 3 Lines 33 – 36)." The customer is then able to use the identification number given to them to access the images they would like to be printed (Column 4 Lines 46 – 50).

15. **Claims 15 – 17** are rejected under 35 U.S.C. 102(b) as being anticipated by **Enomoto et al.** (US Patent 5,974,401/JP 10078918 A **The examiner would like to note that the English equivalent of will be used and a translation of the original patent of JP 10078918 A published in 1998 has been requested**).

16. In regard to **claims 15**, Enomoto discloses a receiving unit operable to receive a plurality of images from a plurality of users (Column 3 Line 16), an image keeping apparatus operable to keep the plurality of images received and recorded therein by the receiving unit (Column 3 Lines 17 – 20), a delivery-medium recording unit operable to

record the plurality of images onto recording media in such a manner that each recording media stores on or more images of the plurality of images that were received from one of the users (Column 8 Lines 27 – 33), a keeping-time monitoring unit operable to monitor a keeping time for each of the plurality of images to determine whether or not the keeping time reaches an end of a predetermined keeping term, the keeping time being a time that has passed after each of the plurality of images was recorded in the image keeping apparatus (Column 8 Lines 20 – 26), and a keeping time notifying unit operable to notify, when the keeping time is determined to reach the end of the predetermined keeping term, a corresponding user of each of the plurality of images that the predetermined term expired (Column 7 lines 4 – 8).

17. In regards to **claim 16**, Enomoto discloses the image keeping apparatus deletes one of the plurality of images for which the predetermined term expired, if no user's instruction is revised from the corresponding user within a predetermined waiting time period after the notification (Column 7 Lines 4 – 8; Column 8 Lines 20 – 26).

18. In regards to **claim 17**, Enomoto discloses a receiving unit operable to receive a plurality of images from a plurality of users (Column 3 Line 16); an image keeping apparatus operable to keep the plurality of images received and recorded therein by the receiving unit (Column 3 Lines 17 – 20); a delivery-medium recording unit operable to record the plurality of images onto recording media in such a manner that each of the recording media stores on ore more images of the plurality of images that were received form one of the users (Column 8 Lines 27 – 33); a payment-mode receiving unit operable to receive an instruction specifying a payment mode from each of the users

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(Column 8 Lines 13 – 14); and a payment processing unit operable to indirectly charge each of the uses in accordance with the specified payment mode (Column 7 lines 48 – 53).

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. **Claim 6, 35 – 35, and 41 – 42** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Fredlund et al.** (US Patent 5,666,215).

21. In regards to **claim 6**, the use of using user ID's in order to access information, especially for online shopping, is well known and common practice in the art.

22. In regards to **claim 35**, it is old and well known that images are captured and stored in digital cameras.

23. In regards to **claim 36**, it is old and well known that digital cameras store the shot date and number of captured images. As a result, when the receiving unit receives the images from the camera, the shot date and number of captured images would be included as well.

24. In regards to **claim 41**, it is old and well known that images are captured and stored in digital cameras.

25. In regards to **claim 42**, it is old and well known that digital cameras store the shot date and number of captured images. As a result, when the receiving unit receives the

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images from the camera, the shot date and number of captured images would be included as well.

26. **Claim 3** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Fredlund et al.** (US Patent 5,666,215) in view of **Komatsu et al.** (US Patent 4,817,050).

27. In regards to **claim 3**, Fredlund is discussed above, but fails to teach a system that is able to record images at predetermined intervals. However, Komatsu does teach a database system that contains a counter that transfers data from one filing system to another after a predetermined period of time lapses (Komatsu Column 7 Lines 59 – 63). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention in view of the teachings of Komatsu to modify Fredlund to include a database with a counter to record images at predetermined intervals, such as after a predetermined period of time has lapsed.

28. **Claims 18 – 22, 25 – 27, 37 – 38, and 39 – 40** are rejected under 35 U.S.C. 103(b) as being anticipated by **Allen et al.** (US Patent 5,737,491) in view of **Fredlund** (US Patent 5,666,215).

29. In regard to **claims 18 and 19**, Allen discloses a camera that is connected wirelessly to a cellular phone (Column 3 Lines 5 – 9) for the transmission of images to a server. In Table 1 a list of commands are disclosed, such as the “Send Prints (address)” command that will send the images to a designated address or number through the cellular phone (Column 2 Lines 1 – 5, Claim 7). It is inherent that these operations must be carried out with the use of a program and a connection-detecting module.

Allen, however, fails to teach that the images capture are transmitted automatically in accordance with an instruction determined by a user in advance.

However, Fredlund does teach the feature of carrying out image orders manually by the photofinisher or automatically. The use of this feature would allow for the image processing to be carried out seamlessly while avoiding any human error that may be introduced through the image processing.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Allen in view of the teachings of Fredlund to introduce a feature to automatically carry out image order in order to avoid human error.

30. In regards to **claim 20**, the examiner understands the monitoring module's function is to just keep track of how many pictures have been taken and that the predetermined number is a number chosen by the user of the camera. It is, therefore, obvious that digital cameras have features that monitor details concerning the camera and the amount of images that have been taken. When the camera can no longer hold any more images because it has reached a predetermined number, which happens to be the maximum number of images that the camera can hold, then the user can transmit the images in a manner that has already been previously discussed above. The examiner would also like to note that the camera does not have to be full in order to send the images. If the user of the camera would like to transmit the images when some predetermined amount chosen by the user of the camera then user can do so.

31. In regards to **claim 21**, Allen discloses that digital images taken by a photographer with a digital camera are transmitted wirelessly to a cellular phone, which

will then be received by an image fulfillment server (Column 1 Lines 60 – 65, Column 3 Lines 5 – 8). These operations are carried out with a microprocessor found within the digital camera (Figure 1).

Allen, however, fails to teach that the images capture are transmitted automatically in accordance with an instruction determined by a user in advance.

However, Fredlund does teach the feature of carrying out image orders manually by the photofinisher or automatically. The use of this feature would allow for the image processing to be carried out seamlessly while avoiding any human error that may be introduced through the image processing.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Allen in view of the teachings of Fredlund to introduce a feature to automatically carry out image order in order to avoid human error.

32. In regards to **claim 22**, Allen discloses a voice recognition program that allows a user to instruct the camera to send images to an external apparatus (Allen Column 3 Lines 49 – 52).

33. In regard to **claim 25**, Allen discloses that the camera "...includes an interface, such as a SCSI port, for connecting to an external input device 27 such as a keyboard or LCD touch screen. The external input device 27 may be used to enter information such as text annotation, electronic addresses of file names that are to be associated with photographer's utterances (Column 2 Lines 63 – 67, Column 3 Line 1)." After the photographer takes the picture, a verbal command can be given to transmit the images (Column 3 Lines 49 – 52).

34. In regards to **claim 26**, it is well-known in the art that a digital camera has a display to view stored images and select which images the user would like to view, one such example is Kodaks' DC4800 Digital Camera

(<http://www.pcstats.com/articleview.cfm?articleID=593>,

<http://web.archive.org/web/20000815073948/www.kodak.com/US/en/digital/cameras/D CSGateway.jhtml>).

35. In regards to **claim 27**, Allen discloses a transceiver that is part of the digital camera (Figure 1, Column 2 Lines 48 – 51).

36. In regards to **claim 37**, it is old and well known that images are captured and stored in digital cameras.

37. In regards to **claim 38**, it is old and well known that digital cameras store the shot date and number of captured images. As a result, when the receiving unit receives the images from the camera, the shot date and number of captured images would be included as well.

38. In regards to **claim 39**, it is old and well known that images are captured and stored in digital cameras.

39. In regards to **claim 40**, it is old and well known that digital cameras store the shot date and number of captured images. As a result, when the receiving unit receives the images from the camera, the shot date and number of captured images would be included as well.

40. **Claims 23 - 24** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Allen et al.** (US Patent 5,737,491) in view of **Komatsu et al.** (US Patent 4,817,050).

41. In regards to **claim 23 and claim 24**, the examiner notes that the fact that the images are transmitted after a predetermined time or quantity has been reached does not affect the actual function of how the images are transmitted, i.e. time and quantity are the same in that they are both measurements that both will carry out the same function of triggering the transmission of the images. With that said, Allen discloses a voice recognition program stored in a camera, which stores images, that is connected wirelessly to a cellular phone, which transmits the images to an external apparatus, such as an image fulfillment server (Allen Column 1 Lines 60 – 65, Column 3 Lines 5 – 8, Column 3 Lines 49 - 52).

Allen fails to teach that the transmission of these images is transmitted after a predetermined number or time has been reached.

However, Komatsu does teach a database system that contains a counter that transfers data from one filing system to another after a predetermined period of time lapses (Komatsu Column 7 Lines 59 – 63).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention in view of the teachings of Komatsu to modify Allen to include a database with a counter to transmit images from the camera to the image fulfillment server after a period of time has lapsed.

42. **Claim 29** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Fredlund et al.** (US Patent 5,666,215) in view of **Allen et al.** (US Patent 5,737,491).

43. In regards to **claim 29**, Fredlund is discussed above, but fails to teach a method of transmitting digital images via a phone.

However, Allen teaches a method of transmitting images taken by a digital camera that is wirelessly connected to a cellular phone to a specified location (Column 3 Lines 5 – 9, Column 2 Lines 1 – 5, Claim 7).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention in view of the teachings of Allen to modify Fredlund's method to include a method of transmitting images to a specified location via a cellular phone.

44. **Claim 31 – 34** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Fredlund et al.** (US Patent 5,666,215) in view of **Allen et al.** (US Patent 5,737,491) in further view of **Enomoto et al.** (US Patent 5,974,401/JP 10078918 A **The examiner would like to note that the English equivalent of will be used and a translation of the original patent of JP 10078918 A published in 1998 has been requested**).

45. In regard to **claims 31 - 34**, it is well known in the art that a customer must present a method of payment at the time that a specific service is completed whether it would be cash or credit. In regards to be charged through a phone company, it is well known in the art that phone companies will charge their customers for any extra services on top of their customers' regularly monthly charges. With that said, Fredlund and Allen are discussed above, but fail to teach a method of payment.

However, Enomoto does teach a payment service in which the customer chooses their mode of payment in the details of the charge (Column 7 Lines 48 – 53).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention in view of the teachings of Enomoto to modify Fredlund and Allen to include a payment service for the delivery of the submitted images.

Response to Arguments

46. Applicant's arguments filed 7/21/2006 have been fully considered but they are not persuasive.

47. In regards to the arguments on:

Drawings

- a. Page 15 Paragraph 2: Priority has been acknowledged
- b. Page 15 Paragraph 3: The drawing objection is withdrawn
- c. Page 15 Paragraph 4: Figure 5 is accepted by the examiner
- d. Pages 15 – 16 Paragraph 5: The drawing objection is withdrawn
- e. Page 16 Paragraphs 1 – 2: The drawing objection is withdrawn

Specification

- f. Page 16 Paragraph 3: The specification objection to the title is withdrawn
- g. Pages 16 – 17 Paragraph 4: The specification objection is withdrawn

Claim Objection

- h. Page 17 Paragraphs 2 – 3: The claim objection is withdrawn
- i. Page 17 Paragraph 4: The claim objection is withdrawn
- j. Page 18 Paragraph 1: The claim objection is withdrawn
- k. Page 18 Paragraph 2: The claim objection is withdrawn

Rejection under 35 USC § 102

Fredlund

- l. Page 18 Paragraph 4: The examiner acknowledges the improper rejections regarding claims 28 and 30 and has corrected them accordingly.

m. Page 18 Paragraph 5 & Page 19 Paragraph 1: The examiner has responded to argument appropriately regarding the automatic feature of the invention. As a result, the rejection is still maintained under 35 USC § 102.

Jackson

n. Page 19 Paragraphs 3 – 5 & Page 22 Paragraph 1: The examiner acknowledges the improper rejection regarding claims 15 – 17, 28 – 29, and 31 – 34. As a result, the examiner has withdrawn the rejection and has applied new art above.

Allen

o. Page 20 Paragraph 2: The examiner acknowledges the improper rejections regarding claims 28 and 30 and has corrected them accordingly.

p. Page 20 Paragraph 3 – 5: The examiner withdraws the rejection made under 35 USC § 102 for claims 18 – 22 and 25 – 27 and has been discussed in detail above.

Fredlund/Komatsu

q. Page 21 Paragraph 1: The examiner maintains the rejection since the applicant has failed to explicitly point out what the error of using the combination of Fredlund and Komatsu.

Allen/Komatsu

r. Page 21 Paragraph 2: The examiner maintains the rejection since the applicant has failed to explicitly point out what the error of using the combination of Allen and Komatsu.

Conclusion

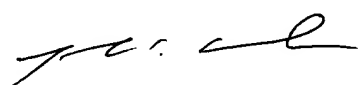
48. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure in which the newly added references can be found on the PTO-892 Notice of References Cited.

49. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerardo Araque Jr. whose telephone number is (571)272-3747. The examiner can normally be reached on Monday - Friday 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GA
10-13-2006


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